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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.             | CONFIRMATION NO.            |
|---|-------------|----------------------|---------------------------------|-----------------------------|
| 10/762,600  | 01/21/2004  | Ichiro Matsuyama     | 1232-5255                       | 5048                        |
| 27123 7590 12/21/2007<br>MORGAN & FINNEGAN, L.L.P.<br>3 WORLD FINANCIAL CENTER<br>NEW YORK, NY 10281-2101 |             |                      | EXAMINER<br>UHLENHAKE, JASON S  |                             |
|   |             |                      | ART UNIT<br>2853                | PAPER NUMBER                |
|   |             |                      | NOTIFICATION DATE<br>12/21/2007 | DELIVERY MODE<br>ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOPatentCommunications@Morganfinnegan.com  
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|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/762,600 | <b>Applicant(s)</b><br>MATSUYAMA, ICHIRO |  |
|                              | <b>Examiner</b><br>Jason Uhlenhake   | <b>Art Unit</b><br>2853                  |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on amendment filed 9/25/2007.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 26,29,30,32,34 and 35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26,29,30,32,34 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/25/2007 has been entered.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 32 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claim(s) are drawn to a computer program per se. A computer program per se is abstract instructions. Therefore, a computer program is not a physical thing (product) nor a process as the are not "acts" being performed. As such, these claims are not directed to one of the statutory categories of invention (See MPEP 2106.01), but are direct to nonstatutory functional descriptive material.

It is noted that computer programs embodied on a computer readable medium or other structure, which would permit the functionality of the program to be realized, would

be directed to a product and be within a statutory category of invention, so long as the computer readable medium is not disclosed as non-statutory subject matter per se (signals or carrier waves).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26,29,30,32,34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Irizawa et al (U.S. Pub. 2003/0085956) in view of Ohtsuka et al (U.S. Pat. 6,145,950), and Reed (U.S. Pat. 6,375,314), Kamada et al (U.S. Pat. 6,128,098), and Katsen (U.S. Pat. 5,803,958).

***Irizawa discloses:***

- ***regarding claims 26, 29, 30, 32, 34-35***, a printing apparatus capable of printing an image on a plurality of types of printing media by selectively using a plurality of types of inks including a pigment ink and dye ink (Paragraphs 0013, 0017, 0024, 0043); a discrimination portion for discrimination whether the type of said ink used for printing the image is said pigment ink or said dye ink (Paragraphs 0013, 0017, 0024, 0043)

- ***further regarding claims 26, 29, 30, 32, 34-35***, a storage portion for storing information indicating applicability relations between different types of inks and

different types of printing media, a second type of printing medium having the applicability relation with said pigment ink but not having the applicability relation with said dye ink, and a third type of printing medium having the applicability relation with said dye ink but not having the applicability relation with said pigment ink (Paragraphs 0013, 0024, 0079, 0087)

***Irizawa does not disclose expressly the following:***

- ***regarding claims 26, 29, 30, 32, 34-35***, a first type of printing media including a printing medium having the applicability relations with both pigment and dye ink; a display portion displaying a plurality of types of printing media
- display control means for controlling display portion, on the basis of information indicating the type of said inks discriminated by discrimination portion and information stored in storage portion, to display the type of printing medium having the applicability relation with the type of ink discriminated by discrimination portion
- a selection portion for selecting, from among two or more types of printing media displayed by display portion, the type of said printing medium used for printing; displaying reference information for selecting the printing medium on which the image is printed on the basis of the type of ink discriminated by the discriminating step;
- wherein the first type of printing medium includes a photo glossy, the second type of printing medium includes a synthetic paper, and the third type of printing medium includes a back print film
- two or more types of printing media are displayed which having the applicability relation with the type of ink discriminated by discrimination portion, and the

type of printing medium is not displayed which having no applicability relation with the type of ink discriminated by discrimination portion

***Ohtsuka discloses:***

- ***regarding claims 26, 29, 30, 32, 34-35***, a display portion displaying a plurality of types of printing media (Column 20, Lines 39-52; Column 21, Lines 7-1); display control means for controlling display portion, on the basis of information indicating the type of said inks discriminated by discrimination portion and information stored in storage portion, to display the type of printing medium having the applicability relation with the type of ink discriminated by discrimination portion (Column 20, Lines 39-52; Column 21, Lines –13), for the purpose of reducing errors in the selection process by the user
- a selection portion for selecting, from among two or more types of printing media displayed by display portion, the type of said printing medium received at the receiving portion there by validating the received paper as said printing medium to be used for printing; displaying reference information for selecting the printing medium on which the image is printed on the basis of the type of ink discriminated by the discriminating step (Column 4, Lines 22-38; Column 20, Lines 39-52; Column 21, Lines 7-30), for the purpose of selecting an appropriate combination of a type of output image, ink and a print medium
- two or more types of printing media are displayed which having the applicability relation with the type of ink discriminated by discrimination portion, and the type of printing medium is not displayed which having no applicability relation with the type of

ink discriminated by discrimination portion (Column 4, Lines 22-38; Column 20, Lines 39-52; Column 21, Lines 7-13), for the purpose of selecting an appropriate combination of a type of output image, ink and a print medium

***Reed discloses:***

- ***regarding claims 36-41***, wherein the printing medium having the applicability relations with both the pigment ink and the dye ink includes a photo glossy paper (Column 2, Lines 44-50), for the purpose of facilitating use of a printer operative to print digital photographs on printable media

***Kamada discloses:***

- ***regarding claims 36-41***, wherein the printing medium having the applicability relation with the dye ink but not having the applicability relation with the pigment ink includes a back print film (Column 12, Lines 38-44), for the purpose of providing a ink with high penetration characteristics. It is well known in the art when printing on the surface of back print film it is necessary for ejected ink to penetrate into the printing material sufficiently when the printing material is printed.

***Katsen discloses:***

- ***regarding claims 36-41***, wherein the printing medium having the applicability relation with the pigment ink but not having the applicability relation with the dye ink includes a synthetic paper (Column 1, Lines 20-26; Lines 31-37), for the purpose of avoiding drawbacks from the use of dye containing inks.

At the time the invention was made it would have been obvious to a person of ordinary skill in the art to incorporate the teaching of Ohtsuka, Reed, Kamada and

Katsen into the device of Irizawa. It would have been obvious to include the known applicability relations of dye and pigment ink with various print media into the discrimination portion of Irizawa, for the purpose of selecting an appropriate combination of a type of output image, ink and a print medium

### ***Response to Arguments***

Applicant's arguments with respect to claims 26, 29, 30, 32, 34, 35 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Uhlenhake whose telephone number is (571) 272-5916. The examiner can normally be reached on Monday - Friday 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.




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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
JSU  
December 13, 2007

  
JULIAN D. HUFFMAN  
PRIMARY EXAMINER  
12/17/07